

REMARKS AND ARGUMENTS

Claims 1, 3, 5-7, 9-11, 13, 15, 16 and 22-27 were pending in the instant application. Claims 1, 3, 5-7, 9-11, 13, 15, 16 and 22-27 were rejected in the Office Action mailed June 19, 2004. Claims 1, 3, 5-7, 9-11, 13, 15, 16 and 22-27 remain pending after entry of the instant paper filed by the Applicants. The Examiner made the following rejection:

- (1) Claims 1, 3, 5-7, 9-11, 13, 15, 16 and 22-27 are rejected under 35 U.S.C. § 102(e) as anticipated by U.S. patent 6,379,929 to Burns *et al.*

The Applicants believe the following remarks traverse the Examiner's rejection of the pending claims. These remarks are presented in the same order as they appear above.

1. The '929 Patent Is Not Prior Art

In the non-final Office Action mailed June 17, 2004, the Examiner states the pending claims are anticipated, under 35 U.S.C. § 102(e), by U.S. patent 6,379,929 to Burns *et al.* Specifically, the Examiner states that: "Burns teaches a microchannel device with a solder / diaphragm valve as claimed (see, e.g., col. 44, lines 9-40, col. 80, lines 1-10)."¹

The Examiner is reminded the '929 patent is a *C.I.P application* which claims priority to provisional application Serial No. 60/031,590 (filed November 20, 1996). As the Applicants noted in the prosecution of another application,² there are significant dissimilarities between the content of the '929 patent and provisional application Serial No. 60/031,590. For example, this provisional application does not include Figure 3A of the issued '929 patent. Therefore, given the substantive differences between the '929 patent and the provisional application to which it claims priority, the filing date of the '929 patent (i.e. November 19, 1997) should be the priority date for this piece of art, absent a showing by the Examiner of relevant material in the provisional application.

¹ Office Action mailed June 17, 2004, page 3.

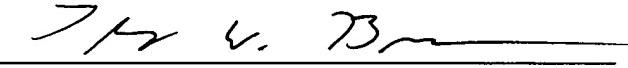
² The Office Action, mailed July 19, 2004, in application Serial No. 09/518,898. While this application is not in the lineage of the instant application, it is part of the patent portfolio of the inventors of record in the instant application.

In contrast, the application to which the instant application claims (immediate) priority is a *continuation application* (Serial No. 08/888,309) filed on July 03, 1997. Given the specification of the instant application is identical to its parent continuation application, the instant application enjoys a priority date of July 03, 1997. Therefore given the filing date (July 03, 1997) of the continuation parent of the instant application pre-dates November 19, 1997 (the filing date / priority date of the '929 patent); the '929 patent may not be raised as prior art in the instant prosecution.

CONCLUSION

In view of the arguments offered above, the Applicants respectfully submit the '929 patent may not be offered as prior art in the prosecution of the instant application and, therefore, the Examiner's pending rejection under 35 U.S.C. 102(e) needs be withdrawn. Should the Examiner believe a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned.

Dated: November 17, 2004



Thomas W. Brown
Registration No. 50,002

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
617.984.0616